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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,094	01/07/2004	Robert K. Kopras	035568-0122	2746

26371 7590 05/26/2006

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EXAMINER

CADUGAN, ERICA E

ART UNIT PAPER NUMBER

3722

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/753,094

Applicant(s)

KOPRAS ET AL.

Examiner

Erica E. Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/7/04&2/27/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Information Disclosure Statement***

2. It is noted that the references that were lined through on the Information Disclosure Statement (IDS) filed February 27, 2005 as not having been considered were lined through because those references were already of record from the IDS filed September 17, 2004. Specifically, U.S. Pat. No.'s 6,443,676, 5,265,657, 5,139,065, 5,062,460, and German Patent No.'s DE 4422247 and DE 1427027 were already of record.

#### ***Drawings***

3. The amendment filed February 27, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The proposed Figures 3D through 3I are not approved because, even though the original specification does teach that the shaft can have a cross-sectional shape of a "triangle, a pentagon, a hexagon, a diamond, a rhombus, an octagon..." (at least paragraph 0051), the specification does not provide for the level of detail shown in the new Figures 3D through 3I. For example, the specification does not teach whether the triangle is a right triangle, an isosceles triangle, a scalene triangle, an equilateral triangle, etc., and specifically does not teach that the triangle is a triangle having the shape shown in Figure 3D, nor that the triangular cross section is configured or located as shown in Figure 3D such that it is intersected by the thumbscrew 22 at the locations of the triangle that are shown in Figure

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3D. With regard to the other shapes claimed, similarly, the specification as originally filed does not teach any details of the polygonal shape beyond the “pentagon, hexagon, diamond, rhombus, or octagon” description, and thus doesn’t teach, with respect to the pentagon, hexagon, diamond, or octagon, whether the sides are of the same length or not, nor does the specification teach how these shapes are positioned or configured with respect to the device such that it is known where they are intersected by the thumbscrew 22. Furthermore, the specification does not appear to teach that the cross-section of each of these shaft shapes is a hollow cross section as is shown in new Figures 3D through 3I.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the shaft having a cross-sectional shape that is selected from a “triangle, a pentagon, a hexagon, a diamond, a rhombus, and an octagon” of claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

5. The amendment filed February 27, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition to paragraph 0051 that refers to the new figures 3D-3I, which, as described above, contain new matter; the new paragraphs 0019A through 0019F, which refer to the new figures 3D-3I, which, as described above, contain new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4 and 6-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the limitation of the body comprising a handle “having a size sufficient to accommodate an entire palm of a power tool user”, in claim 15, the limitation re the gripping surface of a handle portion “having a size sufficient to accommodate the entire palm of a power tool user”, and in claim 25, the limitation re the gripping surface of a handle portion being “configured to accommodate the entire palm of a power tool user” are all limitations that do not appear to be supported by the specification as originally filed.

Examiner notes that paragraph 0044 of the specification teaches that “[T]he handle portion 12 is configured such that the palm of an operator is positioned adjacent to the second surface 32 and the fingers of the operator are positioned adjacent to the first surface 30”. However, this is not a teaching that the “entire” palm is accommodated by the gripping surface. Additionally, there appears to be no teaching in the specification as originally filed regarding the specific size of the gripping surface or the handle, nor any teaching related to what size “palm” is intended to be accommodated. Note that human palm sizes vary widely depending on the size and/or age of the individual in question. For example, a palm of a 10-year old child is likely to be significantly smaller than that of, say, an adult professional basketball player who has hands large enough to palm a basketball.

8. Claims 1-4 and 6-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as set forth in claims 1, 15, and 25 what size or range of sizes qualifies as being of a size that is “configured to accommodate the entire palm of a power tool user”. As noted above, there appears to be no teaching in the specification as originally filed regarding the specific size of the gripping surface or the handle, nor any teaching related to what size “palm” is intended to be accommodated. Note that human palm sizes vary widely depending on the size and/or age of the individual in question. For example, a palm of a 10-year old child is likely to be significantly smaller than that of, say, an adult professional basketball player who has hands large enough to palm a basketball.

In claim 16, as currently set forth, it is unclear if the claimed “third” mode of operation wherein the first attachment is attached to the housing is intended to be different than the claimed “first” mode of operation in which the first attachment is attached to the housing. If they are intended to be the same mode, Examiner suggests changing “a third mode of operation” in claim 16, line 5 to --the first mode of operation--, and then changing “a fourth mode of operation” in claim 16, line 6 to --a third mode of operation--.

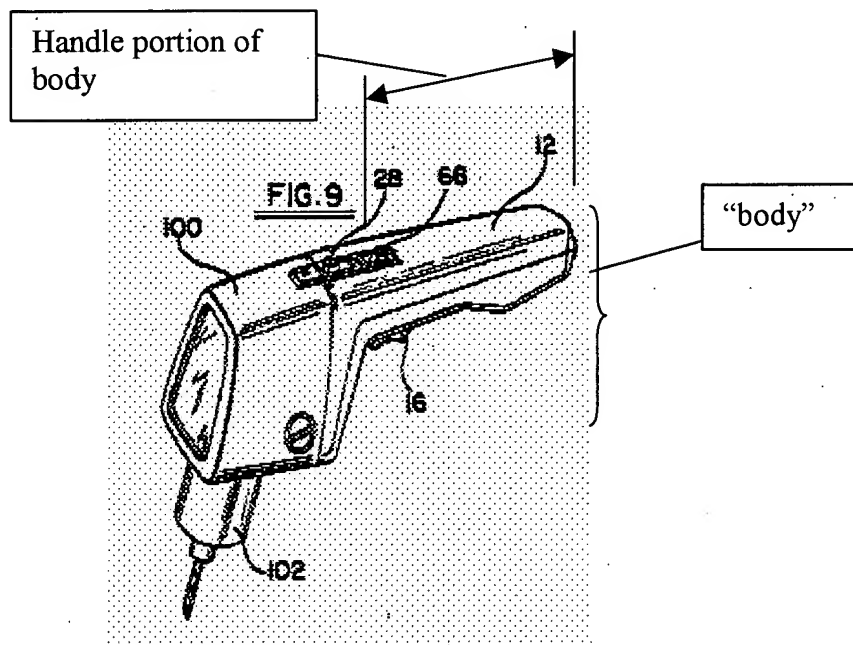
***Claim Rejections - 35 USC § 102/103***

9. Claims 1-4, 6, and 13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, are rejected under 35 USC 103 as being obvious over, U.S. Pat. No. 4,050,003 to Owings et al.

Owings teaches an attachment device including a “body” having a “handle” portion (labeled in the reproduction of Figure 9 below), which attachment is selectively attachable to a rotary cutting tool (for example, see Figures 9 and 13). Note specifically that the handle in

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Figure 9 has at least a portion extending generally perpendicularly to a central longitudinal axis of the rotary cutting tool (see Figure 9).



Re the handle being of a “size sufficient to accommodate an entire palm of a power tool user”, as best understood, it is noted that the upper surface (as viewed in Figure 9) of the “handle” portion would appear to be large enough to support the entire palm of a user of the power tool (see Figure 9).

Re the “base” limitation of claim 1, as broadly claimed, note that the tool head 100 is a “base” coupled to the “body”, and is “selectively adjustable” between extended and retracted positions relative to the “body” (wherein the “extended” position of such is shown in Figure 4 and the “retracted” position in Figure 3, for example). Additionally, broadly speaking, the “base” 100 can be considered to “adjust” the depth of cut between there **being** a depth of cut



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(when the “base” 100 is attached to the “body” to enable the cutting bit to cut a workpiece with a depth of cut) and there **not being** a depth of cut (i.e., a depth of cut of zero, when “base” 100 is not attached to the “body”). It is noted that claim 1 does not set forth that the selective adjustment between extended and retracted positions is how the depth of cut is adjusted.

Re claim 2, also note that the “body” (the left portion of element 12 can be so considered, as viewed in Figure 2) is integral with the handle (see Figure 9 above), and includes members 52 and 54 for coupling the handle to the tool (see Figures 2-4, for example).

Re claim 3, as broadly claimed, note that the element 12 itself can (emphasis added) be rotated (for example, manually about an axis such as the horizontal axis as viewed in Figure 2), and thus either of “members” 28 or 52 are thus “rotatable” (as broadly claimed) in that they are “able” to be rotated. Additionally, note that “member” 28 is inserted into an aperture provided in the tool (see Figures 3 and 9), and that “member” 52 is inserted into an aperture in member 44 (Figures 3, 4).

Re claim 4, note that “member” 54 is annular and is considered a “collar” that “closes around” portion 46 of the tool (Figures 3-4).

Re claim 6, note that 46 is a shaft which is “coupled” to the above-described “base” 100, and which is configured for sliding movement within 54, which can be considered “at least a portion of the body” as claimed (Figures 3-4).

Re claim 13, it is noted that the handle, at least when detached from the tool head, “may” be positioned in an infinite number of positions relative to the tool head, including positions in which the handle can be considered perpendicular to and parallel to the central longitudinal axis of the cutting tool of Figure 9, for example.

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In the alternative, Owings does not explicitly teach that the handle has “a size sufficient to accommodate an entire palm of a power tool user”, and is silent with respect to any particular dimension or dimensions of the tool and/or of the handle.

However, it would have been an obvious matter of design choice to have made the device as a whole taught by Owings of whatever size was desired or expedient to an end user, and in particular to have scaled the size of the entire device such that the handle has “a size sufficient to accommodate an entire palm of a power tool user” as claimed in claim 1, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Note especially that since the element 12 is called a “power handle” by “Owings”, it would appear that the device is likely already (prior to any such modification) at least close to the size claimed (wherein the handle has a “size sufficient to accommodate an entire palm of a power tool user”), and that such a slight change in the size of Owings’ device would not appear to adversely affect the function of Owings’ invention.

10. Claims 1-3, 13-15, 17-20, 22-30, 32-34, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, are rejected under 35 USC 103 as being obvious over, U.S. Pat. No. 5,813,805 to Kopras.

Kopras teaches a handle 14 attachment that is selectively attachable to a housing 12 of a rotary cutting tool (see Figure 1). Note that the handle 14 is substantially perpendicular to the central longitudinal axis (such central longitudinal axis extending generally horizontally as viewed in Figure 1) of the tool when attached thereto, as viewed, for example, from either of the left or right ends (left or right are as viewed in Figure 1).

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Re claim 2, note that the handle is attached to the tool via “members” 72, 74 that extend through apertures of a portion of the handle that can be considered the “body” as broadly claimed (see Figure 2, for example).

Re claim 3, note that “members” 72, 74 are inserted into apertures 64, 66 of the tool (Figure 2).

Re claim 1, “base” 46 is adjustable between “extended” and “retracted” positions relative to the aforescribed “body” (see Figure 2 and col. 4, line 42 through col. 5, line 45, for example) in order to adjust the depth of cut of the tool bit 32 (see Figure 1 and col. 4, lines 42-49, for example).

Re claim 1, it is noted that the handle 14 would appear to be able to “accommodate an entire palm of a power tool user” along at least the top surface thereof as viewed in Figure 1.

Additionally, re independent claim 15, note that any of the surfaces of the handle 14 that are exposed when the handle 14 is attached to the housing 12 are available to be gripped by a user, and thus, as broadly claimed, are considered to be “gripping surfaces”. For example, the end surfaces of the handle 14 (when viewed from either of the right or left end surfaces as viewed in Figure 1) can be considered to be such “gripping surfaces”, noting that the handle could be gripped by pressing a palm to either (preferably even both of them at the same time) of those two surfaces and folding the fingers around the handle (i.e., for the left end, bring the hand down on the tool with the palm facing to the right such that the palm abuts the left end surface of the handle, then curve or fold the fingers at an approximate 90 degree angle such that they contact the back surface of the handle 14). Thus, the handle includes “gripping surfaces” that are “substantially perpendicular” (i.e., more perpendicular than not) to the central longitudinal axis

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of the rotary cutting tool when the handle is attached to the tool (see Figure 1, for example). Furthermore, it would appear, as best understood, that such right and left end surfaces of the handle 14 could be considered to have a “size sufficient to accommodate the entire palm of a power tool user” as set forth in claim 15, or the similar limitation in claim 25.

Re claim 13, it is noted that the handle is detachable. Thus, it is able, at least when detached, to be positioned in an infinite number of positions, including positions in which the handle is “substantially perpendicular” or “substantially parallel” to the central longitudinal axis of the tool.

Re claim 14, note that the handle has locations for storing tools or tool bits 32 as well as tool 40 (see Figures 3-4 and col. 7, line 23 through col. 8, line 10, for example).

Re claims 15 and 25, it is noted that Kopras explicitly teaches that the tool can be operated with or without the handle attached thereto (col. 2, lines 10-18, for example).

Re claim 18, it is noted that the members 72, 74 are rotatable and are configured for insertion into apertures 64, 66 of the housing 12 of the tool, and additionally, it is noted that the ends of the handle 14 form “collars” that close around portions 60, 62 of the housing of the rotary cutting tool (Figures 2, 1, and 4).

Re claim 20, note that the “base” 46 is coupled to a “body” 52 via a “shaft” 54/56.

Re claim 22, as broadly claimed, by virtue of its non-circular cross section, the “shaft” 54/56 is considered to be “configured to resist twisting of the body when the attachment is coupled to the rotary cutting tool” (see Figure 2).

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Re claim 29, note that the “base” 46 “may be” selectively positioned in one of multiple positions between the extended and retracted position by loosening locking knob and sliding the base 46 to another position (Figure 1, col. 4, line 42 through col. 5, line 45, for example).

In the alternative, re the size of the handle (cl. 1) and/or perpendicular gripping surface (cl. 15, 25) thereof, while it appears that such is of a size “sufficient to accommodate the entire palm of a power tool user” as set forth in the claims as described previously, Kopras does not explicitly teach that the handle and/or perpendicular gripping surface thereof are of a “size sufficient to accommodate the entire palm of a power tool user”, and Kopras is silent with respect to any particular dimension or dimensions of the tool in general and/or of the handle.

However, it would have been an obvious matter of design choice to have made the device as a whole taught by Kopras of whatever size was desired or expedient to an end user, and in particular to have scaled the size of the entire device such that the handle has “a size sufficient to accommodate an entire palm of a power tool user” as claimed in claim 1 or such that the aforescribed perpendicular gripping surface has a “size sufficient to accommodate the entire palm of a power tool user” as set forth in claims 15 and 25, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Note especially that since the element 14 is called a “handle” by “Kopras”, and the tool as a whole is described as a “hand-held tool”, it would appear that the device is likely already (prior to any such modification) at least close to the size claimed (wherein the handle and/or gripping surface has a “size sufficient to accommodate an entire palm of a power tool user”), and that

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such a slight change in the size of Kopras' device would not appear to adversely affect the function of Kopras' invention.

11. Claims 1-2, 4, 6, 9, 13, 15, 17, 19-20, 25-26, and 28-30, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, are rejected under 35 USC 103 as being obvious over U.S. Pat. No. 4,572,715 to Wolff.

Wolff teaches an attachment 1 to a rotary cutting tool such as a drilling or milling machine (see abstract for example), which attachment includes handles 12 (see Figure 1). The rotary cutting tool is clamped between the arms or forks of a split ring 5 (see Figure 1 and col. 4, lines 58-61, for example). Thus, the tool axis is vertical as viewed in Figure 1, and the handles 12 extend perpendicular to the vertical as viewed in Figure 1.

Re claim 2, as broadly claimed, the handles 12 are considered to be "integral" with the "body" 7 in that they form a unit therewith and are movable therewith. Note that the "body" 7 is connected to the "member" 5 for coupling the attachment to the tool (Figure 1).

Re claim 4, note that split ring 5 is a "collar".

Re claims 1 and 6, base 2 is "selectively adjustable" between extended and retracted positions relative to the "body" 7 as shafts 3 slide therewithin (see Figure 1 and col. 4, line 51 through col. 5, line 12).

Re claim 1, note that at least the flat (for example shown on the left side of the leftmost handle 12 in Figure 1) circular surface of the handles 12 appears to be large enough that it is of a "size sufficient to accommodate an entire palm of a power tool user" as set forth in claim 1. Note that claim 1 doesn't set forth any particular surface that is of that size, but only sets forth that the "handle" must be of such a size.

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Re claim 9, guide stop 19 is considered to be an “edge guide” that is, as broadly claimed, “selectively coupled” to the base 2 in that the edge guide 19 can (emphasis added) be at least manually taken apart from the base 2, apparently by loosening fixing screws 21 and sliding rods 18 from the channels 17 in the base 2 (see col. 5, lines 13-43 and especially lines 22-32, and also Figure 1).

Re claim 13, at least when the attachment is detached from the tool, the attachment can be located in an infinite number of positions relative to the tool, which positions include those as claimed in claim 13.

Re claims 15 and 25, it is noted that the handles 12 can be gripped along any exposed surface thereof, and that the handles 12 each include a horizontal cylindrical surface as well as a vertical flat surface that can be so gripped, and which are thus considered to be “gripping surfaces” that are perpendicular and parallel (respectively) to the vertical central longitudinal tool axis (Figure 1). Re the perpendicular horizontal cylindrical surface described, it would appear that if the palm was cupped, the entire palm could be wrapped around that surface, and thus it appears that the perpendicular gripping surface has a “size sufficient to accommodate the entire palm of a power tool user” as claimed.

Also re claims 15 and 25, particularly noting that the device shown in Figure 1 is described by Wolff as being able to “interchangeably accommodate” powered hand drills or milling machines (see abstract, for example), and that the attachment device shown in Figure 1 does not have any sort of power supply for the drilling or milling tool (i.e., the drilling or milling tools each have their own power supplying means), it would appear that the rotary drill or

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milling tool has a “second mode of operation without an attachment coupled thereto when the first attachment is removed from the rotary cutting tool”.

Re claim 17, it is noted that the “collar” 5 includes at least two members in that it includes two forks (each of which can be considered a “member” as claimed). Also note that the fastening screw 6 can be considered a “member” as claimed in that it serves to selectively couple the attachment 1 to the tool (see Figure 1).

Re claim 29, it is noted that the base is moved through an infinite number of positions between the extended and retracted positions as the “handles” 12 are used to raise the tool up and down along the shafts 3 (Figure 1).

In the alternative, re the size of the handle (cl. 1) and/or perpendicular gripping surface (cl. 15, 25) thereof, while it appears that such is of a size “sufficient to accommodate the entire palm of a power tool user” as set forth in the claims as described previously, Wolff does not explicitly teach that the handle and/or perpendicular gripping surface thereof are of a “size sufficient to accommodate the entire palm of a power tool user”, and Wolff is silent with respect to any particular dimension or dimensions of the tool in general and/or of the handle.

However, it would have been an obvious matter of design choice to have made the device as a whole taught by Wolff of whatever size was desired or expedient to an end user, and in particular to have scaled the size of the entire device such that the handle has “a size sufficient to accommodate an entire palm of a power tool user” as claimed in claim 1 or such that the aforescribed perpendicular gripping surface has a “size sufficient to accommodate the entire palm of a power tool user” as set forth in claims 15 and 25, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as



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being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Note especially that since the elements 12 are called “hand levers” by Wolff, and at least the drilling tool that is to be supported by the attachment taught by Wolff is explicitly described as a “powered hand drill”, it would appear that the device is likely already (prior to any such modification) at least close to the size claimed (wherein the handle and/or gripping surface has a “size sufficient to accommodate an entire palm of a power tool user”), and that such a slight change in the size of Wolff’s device would not appear to adversely affect the function of Wolff’s invention.

12. Claims 1-4, 6, 9-15, 17-20, 22-23, 25-30, and 32-33, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by, or under 35 USC 103 as being obvious over PCT WO 02/04182 (‘182).

Re claim 1, note that handle 224 is selectively coupled to rotary cutting tool 200 (Figure 7) via a coupling arrangement located at 240 and including lever 241 and also via an attachment collar 238 (Figure 7, paragraph 0060, for example).

Note that the handle 224 is substantially perpendicular to the central longitudinal axis (such central longitudinal axis extending generally vertically as viewed in Figure 7) of the tool when attached thereto, as viewed, for example, from either of the upper or lower ends (upper or lower are as viewed in Figure 7).

Also, re claim 1, note that **at least** the vertical surfaces of the handle 224 appear to be of a “size sufficient to accommodate an entire palm of a power tool user” as claimed (see Figure 7).

Additionally, re independent claim 15, note that any of the surfaces of the handle 224 that are exposed when the handle 224 is attached to the housing 214 are available to be gripped by a

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user, and thus, as broadly claimed, are considered to be “gripping surfaces”. For example, the upper horizontally-extending leg of the handle 224 could be gripped by a user, and thus the handle includes “gripping surfaces” that are “substantially perpendicular” (i.e., “more perpendicular than not” as defined by applicant’s specification in paragraph 0046) to the central longitudinal axis of the rotary cutting tool when the handle is attached to the tool (see Figure 7, for example). Furthermore, when cupping the palm, it would appear that such an upper surface is of a “size sufficient to accommodate an entire palm of a power tool user” as set forth in claims 15 and 25, as best understood.

Re claims 2-3, the upper portion of the handle where the fastening device is located, for example, can be considered the “body”, and the cam shaft of the lever 241 is the “rotatable member” received in an aperture of the tool (see Figures 7, 10, and paragraph 0060-0061).

Re claim 4, see collar 238 in Figure 7 (also paragraph 0062).

Re claims 1 and 6, note that depth guide 212 moves between a retracted and an extended position relative to the “body” via the shaft 252 sliding within a portion of the body (see Figures 7-11 and paragraphs 0063-0064, for example).

Re claim 9, see Figure 12, noting that edge guide 330 is coupled to the base.

Re claims 10-11, see Figure 12, noting that the dust collector would serve to guide the tool if it were pressed against a guide edge.

Re claim 12, see Figure 7, noting the dust collector 300 (see paragraph 0073).

Re claim 13, it is noted that the handle is detachable. Thus, it is able, at least when detached, to be positioned in an infinite number of positions, including positions in which the

handle is “substantially perpendicular” or “substantially parallel” to the central longitudinal axis of the tool.

Re claim 14, note that storage compartment 44 holds a wrench tool (paragraph 0033, Figures 2-3).

Re claims 15 and 25, see paragraphs 30-31, which explicitly teach that the rotary cutting tool can function either with or without the handle attachment coupled thereto.

Re claim 22, note that the shaft 252 is considered, via its non-circular cross section, to “have a cross-sectional shape that is configured to resist twisting of the body when the attachment is coupled to the rotary cutting tool” (Figure 7, for example).

In the alternative, re the size of the handle (cl. 1) and/or perpendicular gripping surface (cl. 15, 25) thereof, while it appears that such is of a size “sufficient to accommodate the entire palm of a power tool user” as set forth in the claims as described previously, ‘182 does not explicitly teach that the handle and/or perpendicular gripping surface thereof are of a “size sufficient to accommodate the entire palm of a power tool user”, and ‘182 is silent with respect to any particular dimension or dimensions of the tool in general and/or of the handle.

However, it would have been an obvious matter of design choice to have made the device as a whole taught by ‘182 of whatever size was desired or expedient to an end user, and in particular to have scaled the size of the entire device such that the handle has “a size sufficient to accommodate an entire palm of a power tool user” as claimed in claim 1 or such that the aforescribed perpendicular gripping surface has a “size sufficient to accommodate the entire palm of a power tool user” as set forth in claims 15 and 25, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as

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being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Note especially that since the element 224 is called a “handle” by ‘182, and the rotary cutting tool is described as a “hand-held power tool” (see at least paragraph 0002) , it would appear that the device is likely already (prior to any such modification) at least close to the size claimed (wherein the handle and/or gripping surface has a “size sufficient to accommodate an entire palm of a power tool user”), and that such a slight change in the size of ‘182’s device would not appear to adversely affect the function of ‘182’s invention.

***Claim Rejections - 35 USC § 103***

13. Claim 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,050,003 to Owings et al. as set forth above, and further in view of U.S. Pat. No. 5,813,805 to Kopras et al.

Owings et al. teaches all aspects of the claimed invention as described above, but does not teach that the handle attachment includes a location for storage of tools or bits for use with the rotary cutting tool.

Noting that wrench 40 is a tool and bit 32 is both a bit and a tool, it is noted that Kopras teaches a handle attachment that provides storage locations/compartments for storing both tool bits as well as other types of tools (see Figure 3, for example).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided storage compartments for storing tools, including tool bits as taught by Kopras to the detachable handle taught by Owings for the purpose of enabling such tools, including the bits, to be kept conveniently at hand, as explicitly taught by Kopras (see col. 7, line 66 through col. 8, line 10, for example).

14. Claims 16 and 35, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopras '805 as set forth above.

Kopras teaches all aspects of the claimed invention as described above, but does not teach a "second attachment" as claimed.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided as many of the tools with detachable handles taught by Kopras as were desired or expedient to an end user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It is noted that the provision of multiple tools/housings with detachable handles results in a situation wherein a second attachment is provided, which attachment is able to be selectively attached to either the first or the second of the tools/housings, and wherein each handle includes gripping surfaces that are substantially parallel to the central longitudinal tool axis, as well as gripping surfaces that are substantially perpendicular to the longitudinal axis (as described in the above rejection based on Kopras). Thus, for example, the first handle can be considered to be the handle with the gripping surface substantially perpendicular to the axis, and the second handle can be considered to be the handle with the gripping surface substantially parallel to the axis (or vice versa since the handles include both parallel and perpendicular gripping surfaces).

15. Claims 16 and 35, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff '715 as set forth above.

Wolff teaches all aspects of the claimed invention as described above, but does not teach a "second attachment" as claimed.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided as many of the tools with the detachable attachment taught by Wolff as were desired or expedient to an end user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It is noted that the provision of multiple tools/housings with detachable attachments results in a situation wherein a second attachment is provided, which attachment is able to be selectively attached to either the first or the second of the tools/housings, and wherein each handle includes gripping surfaces that are substantially parallel to the central longitudinal tool axis, as well as gripping surfaces that are substantially perpendicular to the longitudinal axis (as described in the above rejection based on Wolff). Thus, for example, a handle of the first attachment can be considered to be the handle with the gripping surface substantially perpendicular to the axis, and a handle of the second attachment can be considered to be the handle with the gripping surface substantially parallel to the axis (or vice versa since each of the handles include both parallel and perpendicular gripping surfaces).

16. Claims 16 and 35, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT '182 as set forth above.

'182 teaches all aspects of the claimed invention as described above, but does not teach a "second attachment" as claimed.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided as many of the tools with the detachable attachment taught by '182 as were desired or expedient to an end user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St.*

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Regis Paper Co. v. Bemis Co., 193 USPQ 8. It is noted that the provision of multiple tools/housings with detachable attachments results in a situation wherein a second attachment is provided, which attachment is able to be selectively attached to either the first or the second of the tools/housings, and wherein each handle includes gripping surfaces that are substantially parallel to the central longitudinal tool axis, as well as gripping surfaces that are substantially perpendicular to the longitudinal axis (as described in the above rejection based on '182). Thus, for example, a handle of the first attachment can be considered to be the handle with the gripping surface substantially perpendicular to the axis, and a handle of the second attachment can be considered to be the handle with the gripping surface substantially parallel to the axis (or vice versa since each of the handles include both parallel and perpendicular gripping surfaces).

17. Claims 24 and 34, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT '182 as applied to claims 15 and 25 above, and further in view of U.S. Pat. No. 5,813,805 to Kopras et al.

'182 et al. teaches all aspects of the claimed invention as described above, and though '182 does explicitly teach the provision of the compartment for storing a wrench as described above and even teaches that other storage compartments can be provided (paragraph 0033), '182 does not explicitly teach that the handle attachment includes a location for storage of bits for use with the rotary cutting tool.

However, Kopras teaches a handle attachment that provides storage locations/compartments for storing both tool bits 32 as well as other types of tools (see Figure 3, for example).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided storage compartments for storing tools, including tool bits as taught by Kopras to the detachable handle taught by '182 for the purpose of enabling such bits, to be kept conveniently at hand, as explicitly taught by Kopras (see col. 7, line 66 through col. 8, line 10, for example).

18. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Kopras '805 or Wolff '715 as applied to claims 1, 2, and 5 above, and further in view of U.S. Pat. No. 5,293,915 to Fuchs et al.

Either of Kopras or Wolff teaches all aspects of the claimed invention as described above, but does not teach the claimed "edge guide" of claim 9, nor the "guide" having an "aperture configured for receiving a tool bit therethrough" of claim 10 that is configured for selective coupling with the base.

However, Fuchs teaches a rotary cutting tool having such a guide 18 removably affixed to a base 10 and having a tubular guiding part extending from a surface of the base to abut a portion of a template to thereby guide the cutting tool along the template (see Figures 1 and 5 and col. 2, lines 26-54 and col. 3, lines 29-39).

Re claim 9, note that such a guide 18, as broadly claimed, constitutes an "edge" guide in that it guides the tool along the edge of the template.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the base taught by either of Kopras or Wolff with the template guide taught by Fuchs for the purpose of enabling more precise working to be



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performed by the devices of Kopras or Wolff by enabling the cutting tools thereof to cut in desired template shapes.

***Allowable Subject Matter***

19. Claim 7-8, 21, and 31, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. It is noted that if any amendment made to the claims to overcome the 112 rejections changes the scope of the claim, this indication of allowable subject matter may be changed.

***Response to Arguments***

20. Many of Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Examiner will address any arguments that were not rendered moot herein below.

Re the Kopras reference (US 5813805), Applicant has asserted that "Kopras does not identically disclose an 'attachment for selective coupling to a rotary cutting tool' comprising, in combination with other elements, a 'base coupled to the body for adjusting the depth of cut of the rotary cutting tool that is selectively adjustable between an extended position and a retracted position relative to the body' as recited in independent Claim 1", and goes on to assert that "the element in Kopras referred to the (sic) Examiner is not coupled to the body as recited in Claim 1". However, this is not persuasive. As noted in the above rejection:

Re claim 2, note that the handle is attached to the tool via "members" 72, 74 that extend through apertures of a portion of the handle that can be considered the "body" as broadly claimed (see Figure 2, for example).

Re claim 3, note that "members" 72, 74 are inserted into apertures 64, 66 of the tool (Figure 2).

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Re claim 1, “base” 46 is adjustable between “extended” and “retracted” positions relative to the aforescribed “body” (see Figure 2 and col. 4, line 42 through col. 5, line 45, for example) in order to adjust the depth of cut of the tool bit 32 (see Figure 1 and col. 4, lines 42-49, for example).

Note that the “base” 46 is at least indirectly “coupled” to the aforescribed body via any intervening structure, such as elements 50, 26, 62, 66, and 74, for example (see Figures 1 and 2, for example), and thus the broad limitation “coupled” is met.

Applicant makes the assertion re the Kopras reference (as well as other references) that the Examiner’s “construction of the term ‘gripping surface’ does not accurately represent how one of ordinary skill in the art would understand its usage”, and other similar assertions.

However, this is not persuasive. Examiner notes that if the surface is capable of being gripped, then it meets the meaning of the term “gripping surface”.

Re Applicant’s assertions that the ‘182 PCT may be applicable under a different section of 35 USC 102 than 35 USC 102(b), Examiner notes that, at least for the current set of claims, the provisional application filed 1/8/03 does not appear to support at least the limitations regarding the size of the handle and/or gripping surface being “of a size sufficient to accommodate an entire palm of a power tool user”, and thus, for at least this reasoning, the claims do not receive benefit of that provisional application. Thus, the rejection is properly made under 35 USC 102(b).

Also, with respect to the ‘182 PCT, Applicant appears to be asserting that since ‘182 teaches that surface 26 of the handle 24 is described as a “gripping surface”, that somehow precludes the different surface being described by the examiner with respect to claims 15 and 25 as being considered a “gripping surface”. However, this is not persuasive. It is noted that firstly,

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the claims do not set forth any limitation on **when** the gripping surface is gripped, i.e., in an operating position, or a non-operating non-attached position, for example. The “gripping surface” as claimed can be one that is gripped as the tool is being carried to a storage location, for example. Secondly, it is noted that if the surface is positioned such that it can or is able to be “gripped”, it constitutes a “gripping surface”. Examiner further notes that just because the reference didn’t explicitly teach that the horizontal top surface described by Examiner is a “gripping surface” doesn’t mean that it isn’t a “gripping surface”. Note that there is no teaching in ‘182 that gripping the indicated horizontal top surface is an undesired or bad thing to do. Also note that under certain space constraints, it might even be desirable or necessary for the tool to be gripped at that location.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474.

The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Erica E Cadugan  
Primary Examiner  
Art Unit 3722

eec  
May 24, 2006

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Not  
Approved  
5/24/06  
GAC

FIG. 3D

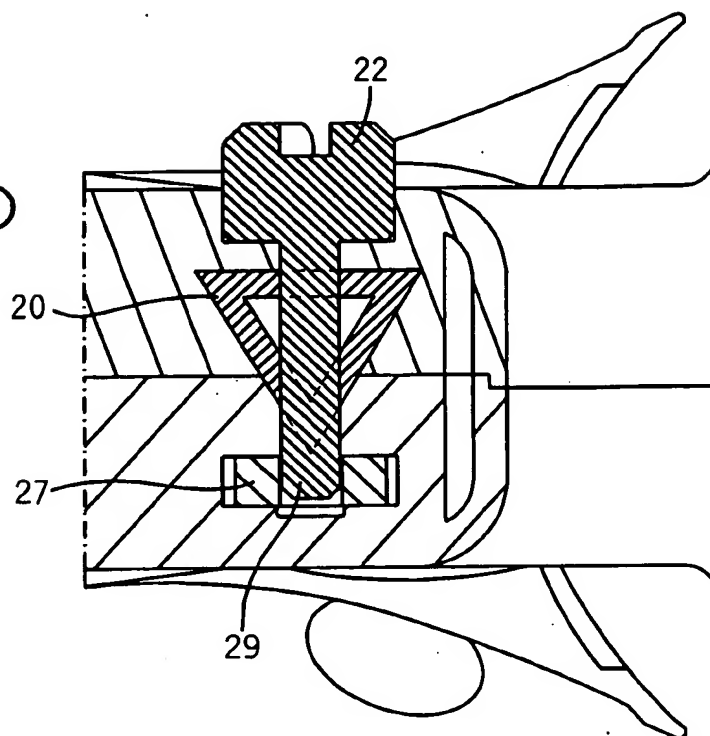
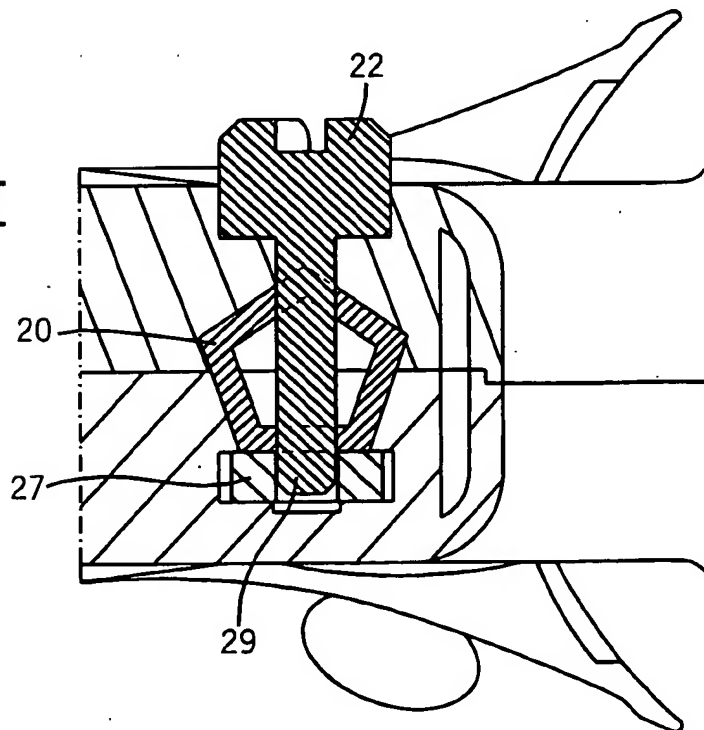


FIG. 3E



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FIG. 3F

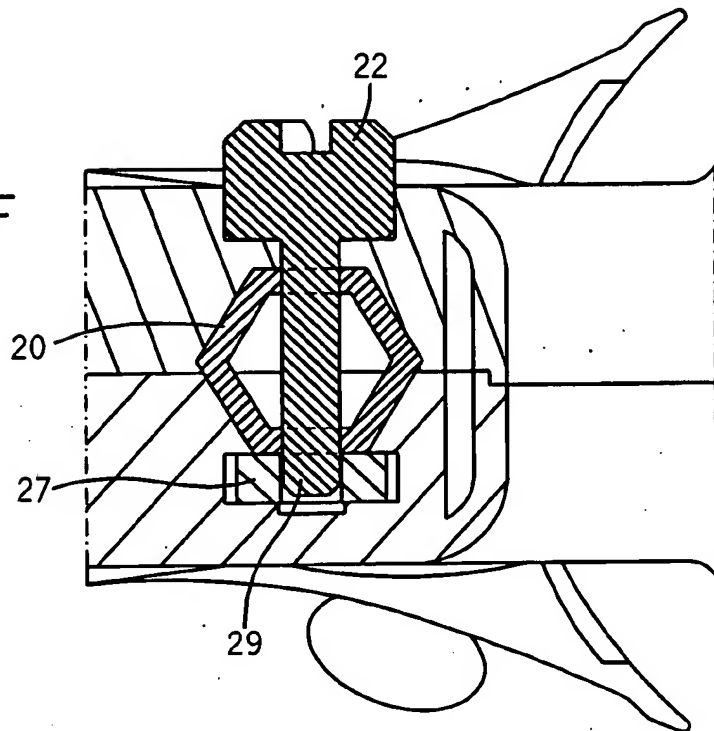
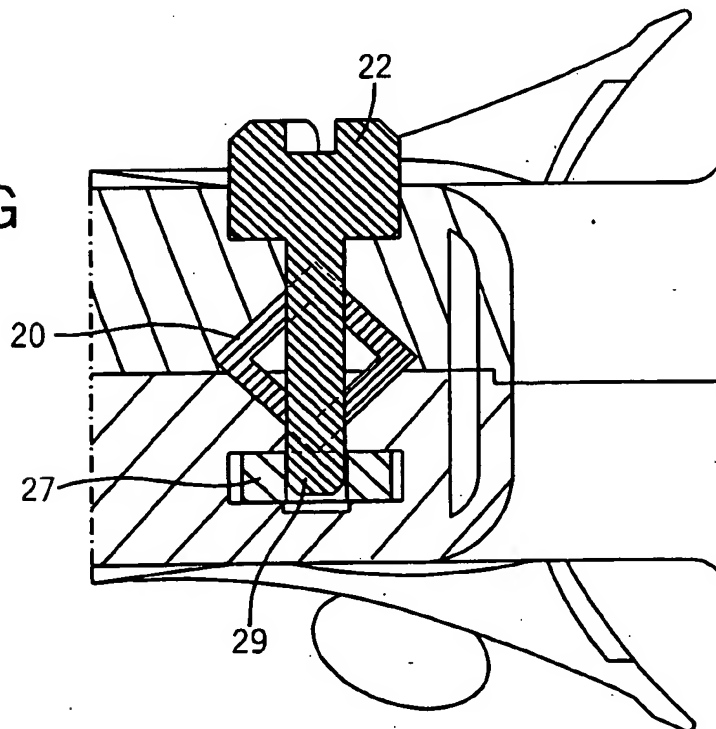


FIG. 3G



Title: ATTACHMENT FOR POWER TOOL

Inventor(s): Kopras et al.

Appl. No.: 10/753,094

New Drawing

7/26

Not Approved  
5/29/06  
Gee

FIG. 3H

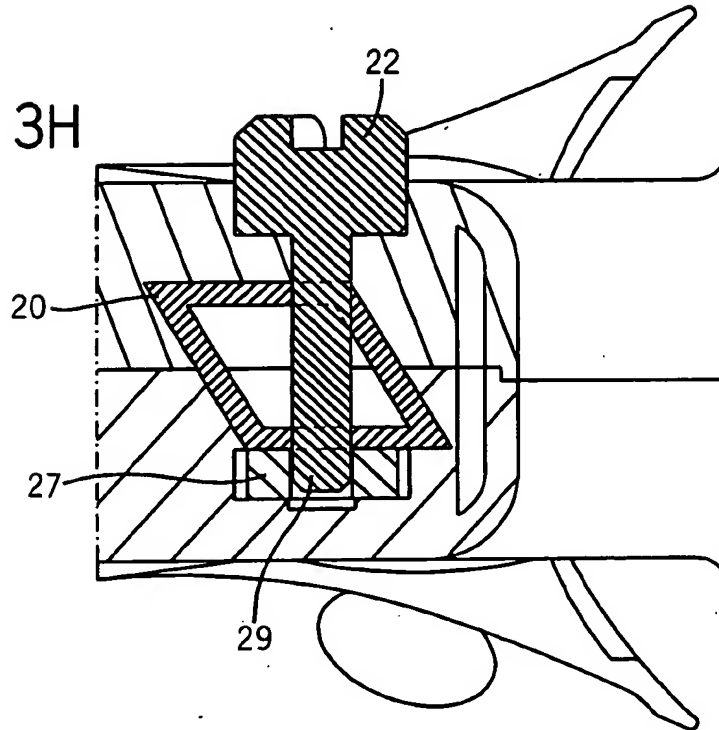


FIG. 3I

